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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,952	12/27/2000	Benoit Pol Menez	PU000187	6466

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EXAMINER

LIM, KRISNA

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/748,952

Applicant(s)

MENEZ, BENOIT POL

Examiner

Krisna Lim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claims 1-12 and 19-21 are pending for examination.
2. The request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/07/05 has been entered.
3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-12 and 19-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Alten et al. [U.S. Patent No. 6,396,546]. Alten et al. Has been used in the parent case.
5. Alten et al. disclosed (e.g., see Figs. 1-43B) the invention substantially as claimed. Taking claims 1 and 19-21 as exemplary claims, the reference disclosed in a television system (an electronic television program guide schedule system, see the title and the abstract) in which at least program title information which are to be transmitted in the future is transmitted in advance to form a channel guide list, apparatus comprising:

a) memory means (lines 6-8 of the abstract, database of Fig. 42, col. 12, line 2) for storing data representing the channel guide list and an e-mail address, the memory means storing user-entered data;

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b) data entry means (e.g., a remote controller or a user interface 31 of Figs. 1 and 3-4) for entering said user-entered data (a keypad, a user interface of Figs. 1, 3 and 4, "the user can revise the content and/or sequential order of the channels ...", col. 12, lines 17-42);

c) control means (a remote controller, lines 8-12 of the abstract, 184 of Fig. 18) for performing a search of said channel guide listing (180 of Figs. 18, 19, 22, 23, 28 and 36B) for a match to specific user-entered information (user control commands in the abstract, selected of Figs. 8-10));

c) on-screen display means (e.g., see on-screen display of Figs. 6A to 10, col. 5) for displaying text or graphic under control of said control means (lines 13-25 of the abstract, on-display of Figs. 18-29); and

means for selecting a television for program for viewing;

upon successful conclusion of said search, said control means sending an e-mail message to the e-mail address to notify said user of a availability of said television program (Pay Per View Confirmation, You have requested to order ... of Fig. 24A).

6. While Alten et al. disclosed the electronic program schedule system which included specific command icons that allowed the user to electronically communicate or interact with the system (e.g., Pay Per View Confirmation or a request to order the movie, etc.), Alten et al. did not explicitly mention that this communication was done by the e-mail method. Using the e-mail method for automatically or electronically passed back and forth information between users/computers through the computer network is a well-known feature in the art at the time the invention was made. Thus, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to recognize that such using e-mail to notify the user would have been obvious existed in

Alten's cable system in order for the user to electronically communicate with the electronic program schedule system.

7. As to claim 2, Alten et al. disclosed the listing to included titles or context of the television (e.g., see Fig. 18, 19, 22, 31, etc.).

8. As to claim 3, Alten et al. disclosed control means (a remote controller, lines 8-12 of the abstract, 184 of Fig. 18) controlled the on-screen means to display a list of user-entered search criteria (180 of Figs. 18, 19, 22, 23, 28 and 36B, user control commands in the abstract, selected of Figs. 8-10, lines 13-25 of the abstract, on-display of Figs. 18-29).

9. As to claims 4-5, using the e-mail method for automatically or electronically passed information back and forth between users/computers through the computer network is a well known feature in the art at the time the invention was made. Thus, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to recognize that such using e-mail to notify the user would have been obvious existed in Alten's cable system in order for the user to electronically communicate with the electronic program schedule system.

10. As to claim 6, while Alten disclosed the use of screen display icon that allowed user to enter information, Alten et al. did not explicitly detail his screen display is a screen display keyboard (e.g., a virtual keyboard). Virtual keyboard is well known

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feature in the art at the time of the invention was made. Thus, such implementation of a well known feature into Alten's screen display that allows user to enter data would have been a matter of using and implementing a well device to enhance his screen display.

11. As to claims 7-9, Alten did not explicitly detail what kind of searching operations/functions are used in his search criteria for selecting and ordering the movie. Using logical operations such as "OR", "AND" or "NOT", "XOR" or whatever logical operations in the advance search are well known in the art the time the invention was made. Thus, such implementation of detail logical operations in the advance search would have been a matter of using and implementing well-known operations.

12. Claims 10-12 are similar in scope as of claims 1-9 and 19-21, and therefore claims 10-12 are rejected for the same reasons set forth above for claims 1-9 and 19-21.

13. Applicant's arguments filed 7/11/05 have been fully considered but they are not deemed to be persuasive. In the remarks, applicant argued in substance that:

a) Nothing in Alten discloses or suggests that the described system of Alten that such a memory means would or could store "at least one e-mail address."

b) Nothing in Alten discloses or suggests the desirability of transmitting the claimed e-mail results of claim 1.

c) The pay per view confirmation is not the same thing as “sending an e-mail message to the user at the at least one e-mail address to notify said user of an availability of said television program.”

d) Alten does not disclose or suggest why a user would want the results of purchasing a movie would or should be transmitted as e-mail to “at least one e-mail address” in the manner suggested by the Examiner.

e) At first paragraph of page 10 of the applicant's remark, applicant argued that the teaching of Alten has nothing to do with disclosing or suggestion how one could send an electronic message to a third party without applying hindsight analysis in view of the applicant's invention.

f) At the second paragraph of page 10 of the applicant's remark, Examiner does not answer why Alten suggests the need for the combination proposed by the Examiner ... The REMINDER feature disclosed by Alten (col. 14, lines 36-55) does not disclose or suggest the need to send such reminders electronic message as emails.

14. As to paragraphs 6 a) to 6 d) above and as mentioned in the previous rejection. Using the e-mail method for automatically or electronically passed back and forth information between users/computers through the computer network is a well-known feature in the art at the time the invention made. In addition as suggested by Alten (e.g., see col. 7, lines 53-58), the data stream can be transmitted on the cable line in any number of ways and those of skill in the art will understand that numerous other transmission schemes can be used to transmit the data stream. Thus, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to recognize that such using e-mail to notify the user would have been obvious as one of the numerous transmission schemes as mentioned by Alten.

15. As to paragraphs 13 e) and 13 f) above, Applicant is reminded not only are the teachings of the prior art taken into consideration, but also the level of ordinary skill in the art in the pertinent art. See *In re Luck*, 177 USPQ 523 (CCPA 1973). And, applicant is also reminded that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. And, it must take into account the knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

16. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisna Lim whose telephone number is 571-272-3956. The examiner can normally be reached on Monday to Wednesday and Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess, can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

August 29, 05



KRISNA LIM
PRIMARY EXAMINER